

REMARKS

Claims 19-26, 28 and 36-44 are pending in this application, claims 20-26 and 28 having been withdrawn from consideration. By this Amendment, claim 19 is amended, claim 27 is cancelled and new claims 36-44 are added. Support for the amendments to claim 19 and new claims 36-44 can be found, for example, in original claims 1, 4-9 and 19. No new matter is added. In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

Claim Objection

The Office Action objects to claim 27. By this Amendment, claim 27 is cancelled, rendering the objection moot. Accordingly, withdrawal of the objection is respectfully requested.

Rejection Under 35 U.S.C. §112, Second Paragraph

The Office Action rejects claim 19 as indefinite under 35 U.S.C. §112, second paragraph. Applicants respectfully traverse the rejection.

By this Amendment, the phrase "on top of each other" in claim 19 is replaced with the phrase "in contact with each other." One of ordinary skill in the art would readily appreciate the metes and bounds of the phrase "in contact with each other."

Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Rejection Under 35 U.S.C. §102

The Office Action rejects claims 19 and 27 under 35 U.S.C. §102(b) over U.S. Patent No. 5,397,634 to Cahill et al. ("Cahill"). Claim 27 is cancelled, rendering the rejection moot as to that claim. As to claim 19, Applicants respectfully traverse the rejection.

Claim 19 recites "[a] protective layer transfer sheet ... comprising: a substrate sheet; a thermally transferable release layer formed on the substrate sheet, the thermally transferable

release layer having a single- or multi-layer structure; and the thermally transferable protective layer formed on the thermally transferable release layer, the thermally transferable protective layer having a single- or multi-layer structure and comprising a thermoplastic resin having a storage modulus at 110 °C of 1×10^5 Pa or less" (emphasis added). Cahill does not teach or suggest such a protective layer transfer sheet.

The Office Action asserts that Cahill discloses a protective layer transfer sheet comprising a thermally transferable protective layer having a single- or multi-layer structure separably provided on a substrate sheet. Notwithstanding this assertion, Cahill does not anticipate and would not have rendered obvious the protective layer transfer sheet of claim 19.

Claim 19 requires a protective layer transfer sheet including a thermally transferable protective layer having a single- or multi-layer structure comprising a thermoplastic resin having a storage modulus at 110 °C of 1×10^5 Pa or less. The Office Action correctly points out that Cahill discloses a protective element including a temporary carrier layer, a protective layer, and an adhesive layer. *See* column 2, lines 33 to 45. However, there is no disclosure that the protective layer (or a combination of the protective layer and the adhesive layer) of Cahill comprises a thermoplastic resin having a storage modulus at 110 °C of 1×10^5 Pa or less. While Cahill may disclose that its protective layer may include polymeric materials such as polyvinyl chloride, polyvinyl butyral, polyesters, etc. (*see* column 3, lines 46 to 52), there is no teaching or suggestion in Cahill that a thermoplastic resin having a storage modulus at 110 °C of 1×10^5 Pa or less could or should be selected and employed in the disclosed protective element.

As Cahill fails to teach or suggest a protective layer transfer sheet including a thermally transferable protective layer having a single- or multi-layer structure comprising a

thermoplastic resin having a storage modulus at 110 °C of 1×10^5 Pa or less, Cahill fails to teach or suggest each and every feature of claim 19.

Claim 19 is not anticipated by Cahill. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

New Claims

By this Amendment, new claims 36-44 are added.

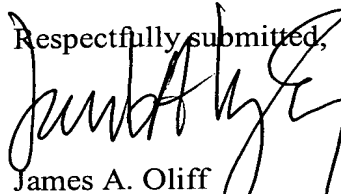
New claims 36-39 depend from claim 19 and, thus, are patentable over the prior art of record for at least the reasons discussed above with respect to claim 19.

New claim 40, similarly to claim 19, recites "[a] protective layer transfer sheet ... comprising: a substrate sheet; a thermally transferable release layer formed on the substrate sheet, the thermally transferable release layer having a single- or multi-layer structure; [and] a thermally transferable protective layer formed on the thermally transferable release layer, the thermally transferable protective layer having a single- or multi-layer structure and comprising a thermoplastic resin having a storage modulus at 110 °C of 1×10^5 Pa or less" (emphasis added), and thus is patentable over the prior art of record for at least the reasons discussed above with respect to claim 19. New claims 41-44 depend from claim 40 and, thus, are also patentable over the prior art of record.

Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 19-26, 28 and 36-44 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

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